

<b>Notice of Allowability</b>	Application No.	Applicant(s)
	10/706,083	KAWAHARA ET AL.
	Examiner	Art Unit
	Karl J. Puttitz	1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to Examiner's Amendment authorized on 7/11/2004.
2.  The allowed claim(s) is/are 1-7.
3.  The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All
  - b)  Some\*
  - c)  None
 of the:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. 10/150106.
  3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5.  A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6.  CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a)  including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1)  hereto or 2)  to Paper No./Mail Date \_\_\_\_\_.
  - (b)  including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1.  Notice of References Cited (PTO-892)
2.  Notice of Draftsperson's Patent Drawing Review (PTO-948)
3.  Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4.  Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5.  Notice of Informal Patent Application (PTO-152)
6.  Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7.  Examiner's Amendment/Comment
8.  Examiner's Statement of Reasons for Allowance  
 Other \_\_\_\_\_.

*Johann Richter*  
JOHANN RICHTER  
PATENT EXAMINER  
GROUP 161

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Donald Drummond on July 11, 2004.

Cancel claims 8-24.

Claim 1, delete "-type-";

Claim 2, delete "-type-";

Claim 5, delete "-type-";

Claim 5, after "protecting" insert - - group- -;

Claim 6, delete "-type-";

Claim 7, delete "type".

The following is an examiner's statement of reasons for allowance:

A search of the prior art failed to uncover any reference that teaches, or suggests to those of ordinary skill, to modify any known chemical reaction to include a step of preparing a compound of formula (2) by reacting a compound of formula (1) with 3-methylcrotonic acid. In this same connection, the compound of formula (2) is novel as the prior art fails to teach those compounds of formula (2) where R is a sulfonyl group. Therefore, the prior art fails to provide motivation to those of ordinary skill to modify known process to include a final product that is a compound of formula (2). Specifically,

Winstein (in the Information Disclosure Statement) teaches the preparation of 3-(3,4-dimethoxyphenyl)-3-methylbutyric acid from condensation of 3-methylcrotonic acid and veratrole. However, this reference does not provide any motivation to modify the veratrole reagent to include a sulfonyl protecting group. Notwithstanding the fact that sulfonyl protecting groups are known in the art, this, at most, would be an obvious to try rationale, since this would amount to using a variety of known groups, like that of the instant sulfonyl group. However, this is not the standard: "The admonition that "obvious to try" is not the standard under section 103 has been directed mainly at two kinds of error. In some cases, what would have been obvious to try would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful."

See M.P.E.P. 2100.

Thus, the prior art fails to synthesize of a compound of formula (2) using a reagent of formula (1) wherein R is a sulfonyl protecting group.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday-Friday (alternate).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Karl J. Puttlitz  
Assistant Examiner

*Johann R. Richter*  
Johann R. Richter, Ph.D., Esq.  
Supervisory Patent Examiner  
Biotechnology and Organic Chemistry  
Art Unit 1621  
(571) 272-0646